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JUN 24 2008

OFFICE OF PETITIONS

In re Application of :
Galperin et al. :
Application Number: 09/942983 : ON PETITION
Filing Date: 08/30/2001 :
Attorney Docket Number: :
EXP.046A :

This is a decision in reference to the petitions filed on April 30, 2008, which are treated as (a) a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a) in that a person sought to be added as a named inventor will not sign the statement of lack of deceptive intent; (b) a petition under 37 CFR 1.47(a) with regard to the person sought to be added a named inventor; and (c) a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.64 which requires that a named inventor execute a supplemental declaration.

The petition is again **DISMISSED**.

Applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a), 1.183 and 1.48," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

On August 30, 2001, the above-identified application was filed. On December 3, 2001, a declaration in compliance with 37 CFR 1.63 was filed, naming Yuri Galperin, Vladimir Fishman, and William E. Eginton as joint inventors.

On September 19, 2007, the initial petitions were filed. Petitioners request that Charles L. Jones, III be added as a

named inventor under 37 CFR 1.48(a). Petitioners further request waiver under 37 CFR 1.183 of 1.48(a) in as much as Jones refuses to sign the statement of lack of deceptive intent and the declaration under 37 CFR 1.63. A petition under 37 CFR 1.47(a) is requested in that the inventor sought to be added, Jones, refuses to sign the declaration under 37 CFR 1.63 naming the inventive entity. Lastly, petitioners also request waiver under 37 CFR 1.183 of 1.64 in that a named inventor, William Eginton, refuses to execute the supplemental declaration naming him as a joint inventor along with Yuri Galperin, Vladimir Fishman, and Charles L. Jones, III.

On October 26, 2007, the petitions were dismissed.

On April 30, 2008, the subject renewed petition was filed. Petitioners again request waiver of 37 CFR 1.48(a) in that Jones refuses to sign the statement of lack of deceptive intent and the declaration under 37 CFR 1.63. Petitioners also again request consideration under 37 CFR 1.47(a) in that the inventor sought to be added, Jones, refuses to sign the declaration under 37 CFR 1.63 naming the inventive entity. Petitioners further state that inventor William Eginton has now signed the supplemental declaration naming him as a joint inventor along with Yuri Galperin, Vladimir Fishman, and Charles L. Jones, III.

In support, petitioners have provided a declaration by petitioner's registered patent practitioner, Ted M. Cannon, in which attorney Cannon states that he repeatedly sent the application as filed and the statement of lack of deceptive intent to Jones, but that no response was received. Copies of the cover letters transmitting the application and statement of lack of deceptive intent to Jones' last known address have also been included.

Petition Under 37 CFR 1.183 to Waive 1.48(a).

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

(1) a petition including a statement from each person being added and each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;

(2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;

(3) the fee set forth in 37 CFR 1.17(i), and

(4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

With regard to the request to add Charles L. Jones, III, petitioners have provided the written consent of the assignee, and state that Jones' address is unknown and he could not be reached by email.

The petition lacks item (2).

With regard to item (2), as discussed *infra*, the declaration is defective in that it does not include the residence and mailing address for all of the inventors as required by 37 CFR 1.63.

Petition Under 37 CFR 1.47(a).

As stated above, petitioners have provided a statement from registered patent practitioner Ted M. Cannon stating that he has sent multiple copies of the application to Jones, who has failed to sign and return the declaration. Copies of the cover letter transmitting the application to Jones have also been provided.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (2).

With regard to item (2), the declaration submitted with the present renewed petition is defective because it does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or a supplemental oath or declaration.

Additionally, the the oath or declaration is insufficient because it does not list the complete mailing address for It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Specifically, the residence and mailing address for joint inventor Galperin has been omitted or obscured such that a portion of the city name is not readable.¹ Additionally, the ZIP Code has been omitted.

Petitioner should submit either a supplemental declaration in accordance with 37 CFR 1.64 and 1.67, naming all of the inventors and signed by joint inventor Galperin containing the residence and mailing address, or an Application Data Sheet in compliance with 37 CFR 1.76 to correct the residence and mailing address for joint inventor Galperin.

Petition Under 37 CFR 1.183 to Waive 37 CFR 1.64.

As previously signing inventor Eginton has signed the supplemental declaration, there is no need for a petition under 37 CFR 1.183 to waive 1.64. However, as the declaration is still defective has stated above, the decision will be held in abeyance pending submission of a supplemental oath or declaration or Application Data Sheet to correct the residence and mailing address for inventor Galperin.

The petition is therefore dismissed without prejudice to reconsideration pending submission of a supplemental oath or declaration or an Application Data Sheet correcting the above-referenced matters.

It is noted that petitioner has submitted fees for a four (4)-month petition for extension of time as well as for the petitions under 37 CFR 1.183, 1.47(a), and 1.48. As the fees for the petitions under 37 CFR 1.183, 1.47(a), and 1.48 were previously paid, the duplicate payments are unnecessary and will be credited

¹ The original oath or declaration lists the city as "Oak Hill." The present declaration lists the city as "Oak" with an apparent obliteration of the remainder of the city name and the ZIP Code.

to counsel's deposit account, as authorized in the subject petition.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.


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